

Docket No. 49298-035
Application No. 09/737,616
Amdt. dated May 21, 2004 in Reply to the O.A. dated Feb. 26, 2004

REMARKS

Claims 1-21 are now presented for examination. Claims 1, 13, and 16 are independent.
Claims 1-21 have been amended.

In the Office Action, claims 1-21 were rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter. Claims 1-21 were rejected under 35 U.S.C. § 102 as anticipated by U.S. Patent No. 5,710,886 (Christensen) or U.S. Patent No. 5,759,101 (Von Kohorn). Claims 1-21 were also rejected under 35 U.S.C. § 103 as obvious over the quiz show Jeopardy. The Office Action also included a request for information under 37 CFR § 1.105.

Response to the Request for Information Under 37 CFR § 1.105

In response to the request for information under 37 CFR § 1.105, applicants note that they have not performed a prior art search. There are no patents, published applications, or published literature by any of the inventors that relate to the claimed invention. An inquiry within Medsite Inc. (the assignee of this application) for related information that predated the application was made, and two undated marketing items were found. Copies of those items are attached hereto as Exhibits A and B. Exhibit B was provided to applicants' attorney on September 10, 1999, and was used by applicants' attorneys to draft provisional application 60/172,688, which was filed on December 20, 1999.

Applicants note that some important prior art is described in the specification at pages 2-4, and the following few paragraphs describe additional prior art that may be relevant to the claims.

Docket No. 49298-035
Application No. 09/737,616
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A popular prior art system for marketing pharmaceuticals to doctors was for a sponsor to invite the doctors to a meeting or a teleconference at which information about the pharmaceutical is presented to the doctors. Such marketing efforts have typically been targeted at doctors who are likely to prescribe the sponsor's products, based on the doctors' prescribing history or specialization. And typically, the doctors are awarded an honorarium (e.g., a medical book or a stethoscope) for attending.

During the meeting or teleconference, the sponsor usually presents clinical information about the pharmaceutical, such as data describing its applications and efficacy, and an explanation of potential side effects. This process is sometimes called "detailing." The embodiments described in the above-identified application was originally intended to serve as an alternative and/or improvement to this type of in-person or teleconference marketing.

The §101 Rejection of Claim 1

Claim 1 has been amended to recite "at least one computer-readable memory in which computer-executable instructions are stored, wherein execution of the instructions by at least one computer causes the at least one computer to implement or initiate [the subsequently listed steps]." This claim is now a *Beauregard* style claim for a computer program embodied in a tangible medium, see *In re Beauregard*, 53 F.3d 1583, 35 USPQ2d 1383 (Fed. Cir. 1995), and is therefore believed to be statutory subject matter. Applicants submit that this amendment obviates the rejection under 35 U.S.C. § 101.

Docket No. 49298-035
Application No. 09/737,616
Amdt. dated May 21, 2004 in Reply to the O.A. dated Feb. 26, 2004

The §102 Rejections of Claim 1 over Christensen or Von Kohorn

Claim 1 includes, inter alia, the steps of: (a) inviting a user to visit a web site; (b) presenting material that promotes the product or service to the user when the user visits the web site; and (c) presenting questions to the user, wherein the questions test whether the material presented in the material-presenting step has been absorbed by the user.

Because element (c) of claim 1 uses an antecedent reference back to "the material presented in the material-presenting step," claim 1 requires the questions presented in step (c) to relate to the same material that was presented during the material-presenting step. The relationship between these two steps is depicted in FIG. 3, at steps S30 and S32, which are labeled "send info about the product to user" and "send quiz about the product to user" (emphasis added). The fact that the questions must relate to the same material that was previously presented is also stressed at page 4, lines 7-19 and page 19, lines 27-29, which indicate that an object of the invention is to ensure that the provided information has actually been absorbed.

Applicants recognize that Von Kohorn describes presenting material that promotes products and/or services. See, e.g., col. 3, lines 44-46. Applicants also recognize that Von Kohorn describes presenting questions to users. See e.g., col. 3, lines 56-57. To clarify the relationship between the questions that are presented in the question-presenting step and the material that is presented in the material-presenting step, claim 1 has been amended to explicitly recite that the questions posed in the question-presenting step must test whether the presented

Docket No. 49298-035

Application No. 09/737,616

Amdt. dated May 21, 2004 in Reply to the O.A. dated Feb. 26, 2004

material has been absorbed by the user. Applicants have found no teaching or suggestion of that feature in the cited art, and claim 1 is therefore believed allowable over that art.

The §103 Rejection of Claim 1 over the Game Show Jeopardy

Claim 1 includes, *inter alia*, the steps of: (a) inviting a user to visit a web site; (b) presenting material that promotes the product or service to the user when the user visits the web site; and (c) presenting questions to the user, wherein the questions test whether the material presented in the material-presenting step has been absorbed by the user.

Applicants note that claim 1 was drafted to provide correct antecedent basis in compliance with MPEP § 2173.05(e). The first time the word “user” appears in claim 1 is in step (a), using the phrase “inviting a user.” After that, subsequent references to the phrase “the user” always refer to the same user.

The Office Action takes the position that claim 1 reads on the game show Jeopardy, and is usually consistent in mapping the “user” recited in claim 1 onto the contestant in Jeopardy. However, when it reached step (b) of claim 1, the Office Action indicated that step (b) reads on “stor[ing] quizzes on cards or display screen servers for audience display and then announcing a return after a short station break (usually for advertisements to promote products or services as claimed).” From this statement, it seems that the Office Action has mapped the “user” recited in step (b) of claim 1 onto the audience in Jeopardy, because the products are promoted to the audience – not the contestant. Applicants submit that it is improper to map the word “user” onto two different entities in order to reject the claims in this manner, because it would violate the

Docket No. 49298-035
Application No. 09/737,616
Amdt. dated May 21, 2004 in Reply to the O.A. dated Feb. 26, 2004

conventions of antecedent basis under which the same word refers to the same thing. Applicants therefore respectfully request withdrawal of the § 103 rejection over Jeopardy.

As understood by applicants, the only material that is presented to the contestant during the game Jeopardy include (1) a list of categories, (2) a choice of dollar amounts, and (3) answers to questions. None of these items “promote promotes the product or service to the user [i.e., the contestant]” as recited in claim 1. Claim 1 is therefore believed patentable over Jeopardy.

Moreover, step (c) recites “presenting questions to the user, wherein the questions test whether the material presented in the material-presenting step has been absorbed by the user” Although the “answers” provided by the host in Jeopardy all relate to one of the categories that are displayed at the beginning of the game, those categories cannot possibly correspond to the “material presented in the material-presenting step” in claim 1 because the categories themselves do not “promote [a] product or service” as recited in step (b). Claim 1 is therefore believed patentable over Jeopardy for this additional reason.

Finally, an attempt to read claim 1 on Jeopardy by mapping the word “user” onto the audience and mapping element (b) onto the commercials that are presented to the audience would also fail, because questions that relate to the commercials are never presented to the audience of Jeopardy.

The Rejections of Claims 13 and 16

Docket No. 49298-035
Application No. 09/737,616
Amdt. dated May 21, 2004 in Reply to the O.A. dated Feb. 26, 2004

Claims 13 and 16 contain limitations that are almost identical to the limitations discussed above in connection with claim 1, and claims 13 and 16 are therefore believed patentable for the same reasons as claim 1.

Conclusion

The other claims in this application each depend on one of the independent claims discussed above and are therefore believed patentable for the same reasons. Since each dependent claim is also deemed to define an additional aspect of the invention, however, the individual reconsideration of the patentability of each on its own merits is respectfully requested.

In view of the foregoing amendments and remarks, Applicants respectfully request favorable reconsideration and early passage to issue of the present application.

Docket No. 49298-035
Application No. 09/737,616
Amtd. dated May 21, 2004 in Reply to the Q.A. dated Feb. 26, 2004

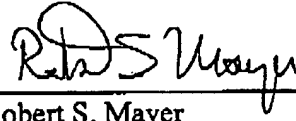
Applicants' undersigned attorney may be reached by telephone at (212) 969-3246 or by facsimile at (212) 969-2900. Please direct all correspondence to Customer No. 21890 at the address provided below.

Respectfully submitted,

PROSKAUER ROSE LLP

Dated: June 25, 2004

By:



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Reg. No. 38,544

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Appendix A

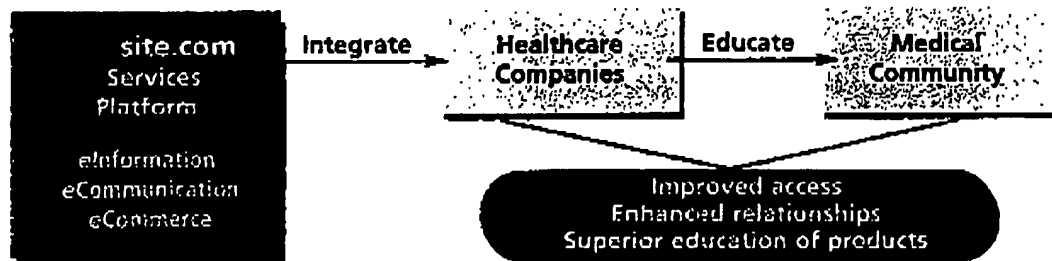
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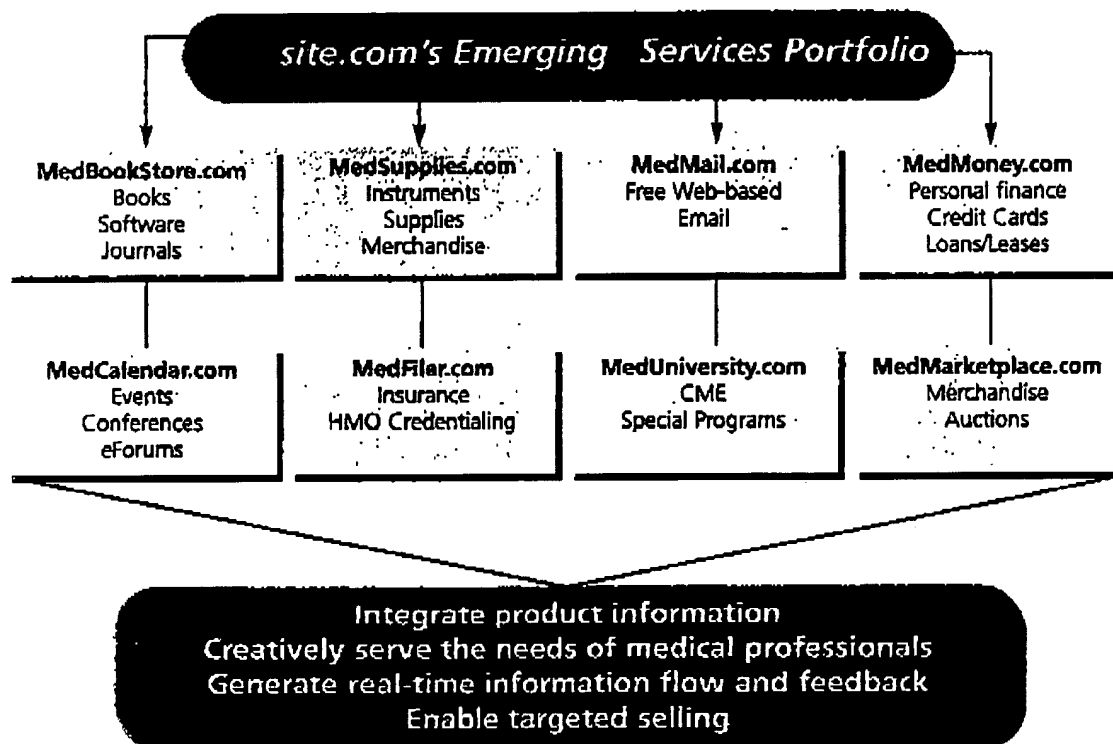


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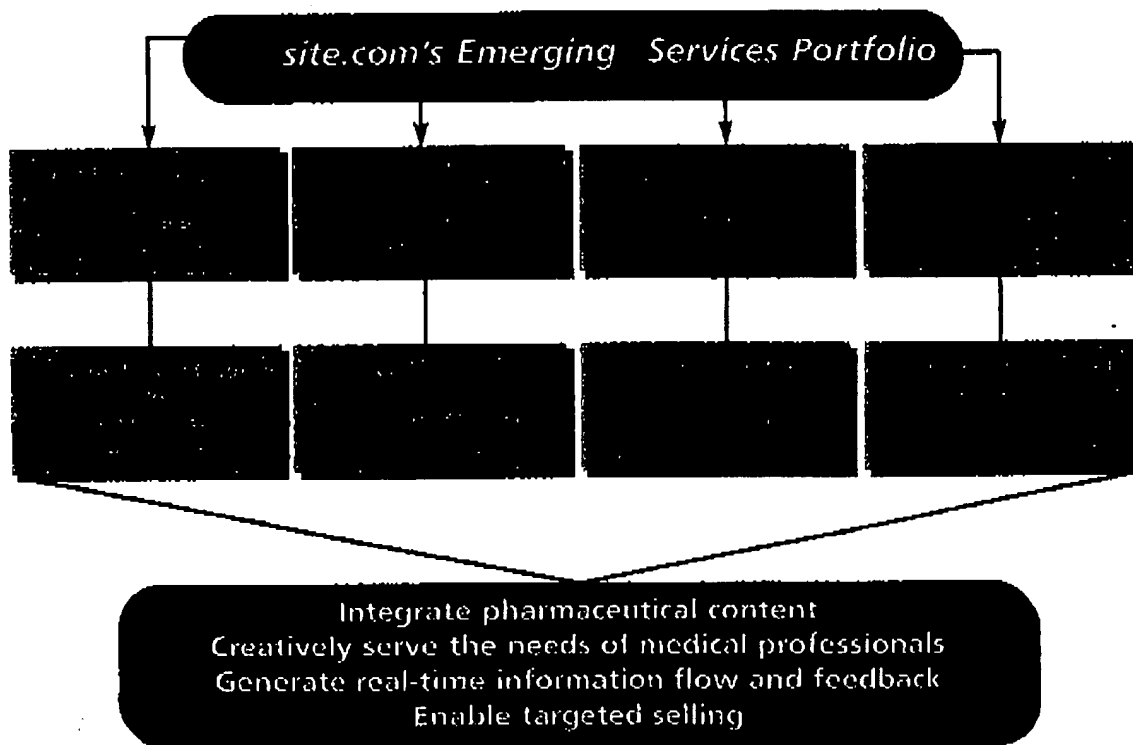


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— Scrip Magazine, 1999

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Appendix B

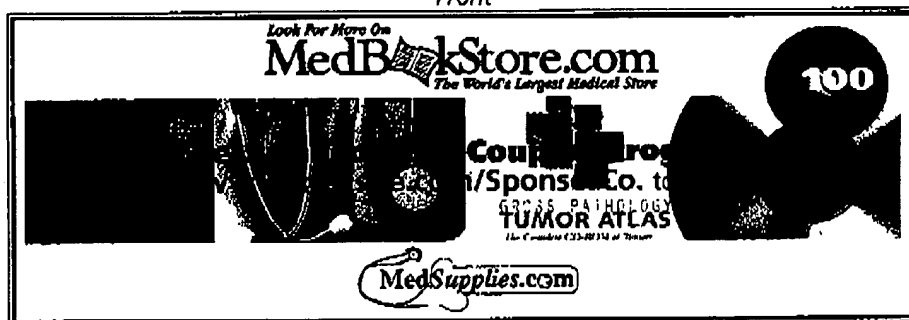
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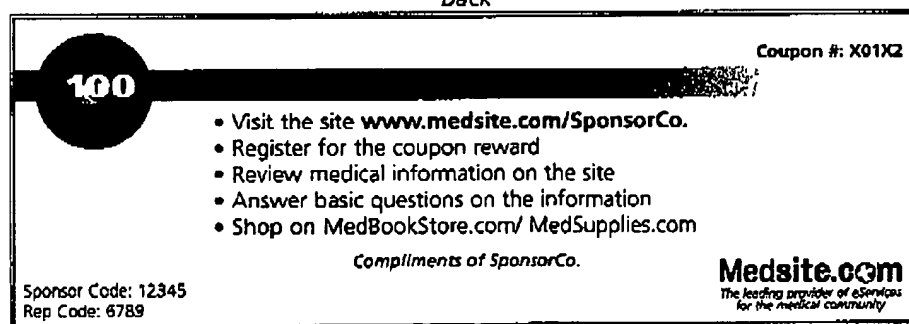
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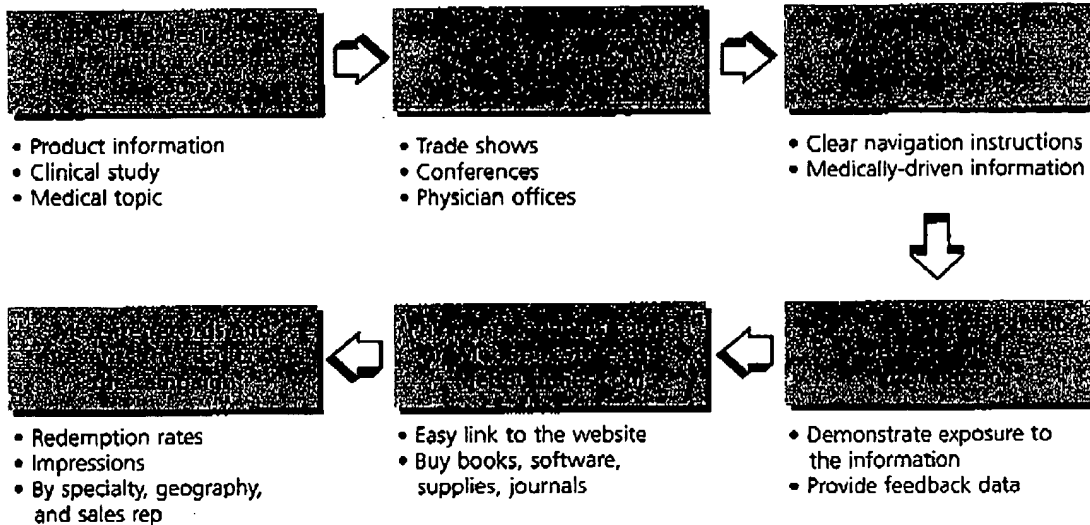


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